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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,519	11/30/2001	Etienne Degand	4004-025-30	6858

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Patent Prosecution Services
Piper Marbury Rudnick & Wolfe
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Washington, DC 20036-2412

EXAMINER

JEFFERY, JOHN A

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,519

Applicant(s)

DEGAND ET AL.

Examiner

John A. Jeffery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 8 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB2186769 in view of EP401754. GB2186769 discloses an automotive glass plate comprising an electrically-heatable transparent solar control coating 32. See Page 1, lines 63-99. The heatable coating constitutes a "solar control coating" in view of its ability to reflect solar heat as noted on Page 1, lines 63-64.

As best seen in Figs. 2-5, 9, and 15, slits 34 are provided that inherently form "data transmission windows" as claimed. As is well known in the art, any structure that is not completely electromagnetically shielded will allow electromagnetic energy to pass through the structure. Shielding typically involves covering, surrounding, or encompassing the area to be shielded with a shielding material -- typically metal.

But shielding must be complete to be effective. Any area that is unshielded -- however small -- will inevitably allow electromagnetic energy to leak through the shield and pass through the area. Therefore, because the slits 34 of GB2186769 are devoid

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of metallic material, the slits provide ample unshielded area to enable electromagnetic energy to pass unimpeded.

In addition, as best seen in Fig. 11B, the presence of the slits in several embodiments does not provoke a significant perturbation in the heating arrangement of the coating layer. As noted in Page 2, lines 41-45, the current is uniformly applied to substantially the entire surface of the film in Fig. 11B. Note the dotted lines in the figure indicating uniform current flow (i.e., without significant perturbation). See also Fig. 12B (indicating uniform current flow between bus bars).

The claims differ from GB2186769 in calling for the glass plate to be a windscreen. Although GB2186769 does not expressly state the automotive glass plate is used as a windscreen, the reference states on P. 1, lines 7-9 that it is used as an automotive "window glass." This teaching, along with the trapezoidal shape of the glass shown in the figures that closely resembles a windscreen, strongly suggests the glass plate's use as a windscreen.

Nevertheless, using such heated glass plates using thin film electric heaters for either windscreens or rear windows is well known in the art. EP401754, for example, teaches providing an electrically-heated glass plate for use either as a windshield or a rear window. See col. 3, line 50 and col. 4, lines 3-4. The windscreen is heated by a thin-film resistor. Col. 3, lines 53-58. In view of EP401754, it would have been obvious to one of ordinary skill in the art to utilize the electrically-heated glass plate of GB2186769 as a windscreen so that ice and frost was melted therefrom, thus enabling clear vision through the windscreen.

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Regarding claims 15 and 17, EP401754 also notes in col. 3, lines 53-58 the desirability of uniformly heating the glass. In view of EP401754, it would have been obvious to one of ordinary skill in the art to uniformly heat the glass in the previously described apparatus to provide deicing heat uniformly along the glass.

Regarding claim 12, the dimensions of the data transmission window claimed in subparagraphs (h) and (i) of the claim merely sets forth the optimum dimensions of the window -- an engineering design choice well within the scope of routine experimentation by those skilled in the art. It is well settled that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233,235 (CCPA 1955). Here, because the general conditions of the claim are met by the prior art, namely areas of the transparency that are devoid of metallic coating that constitute "data transmission windows," the specific dimensions of such windows is merely an optimization readily discoverable via routine experimentation and does not therefore constitute a patentably distinguishable feature.

Response to Arguments

Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection. The examiner, however, notes that while GB2186769 ("GB 769 ") does not expressly state that electromagnetic energy in the form of data can pass through the slit, the slits nonetheless will enable the passage of electromagnetic energy therethrough.

Applicant argues that “the transmission of electromagnetic data cannot be envisaged with slits having a width of several microns.” Remarks, at 6. Applicant also argues that mere “leakage” through a slit cannot be equated with a data transmission window. *Id.* But applicant has not provided any evidence whatsoever to support this assertion. The examiner maintains that because the slits of GB 769 are devoid of any metallic material, electromagnetic energy -- even in the form of data -- will pass through the slits.

Applicant also argues that the prior art does not show the bus bar arrangement of independent claims 8 and 11. *Id.* at 7. But GB '769 in all the figures shows bus bar structures along the top, bottom, and side edges of the transparency that meet the claimed limitations. The rejection is proper.

Lastly, applicant asserts there is no motivation to combine EP '754 with GB 769 allegedly because (1) EP does not suggest a data transmission window, and (2) data transmission windows cannot be equated with the art of thin film electrically heated windscreens.

The examiner respectfully disagrees. The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209

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(CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As noted in the rejection, the EP reference was cited merely to show that it is known in the art to use thin film electric heaters for either a front or rear windscreen. The relevant field of endeavor is electrically heated vehicle transparencies generally. EP 754 is well within that field of endeavor. There is ample motivation to combine the two references and the rejection is proper.

Final Rejection

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (571) 272-4781. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (703) 305-5766. All faxes should be sent to the centralized fax number at (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "John A. Jeffery", with a stylized, flowing script.

**JOHN A. JEFFERY
PRIMARY EXAMINER**

12/8/04